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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,594	11/02/2004	Son Nguyen-Kim	260493US0PCT	5264
22850	7590	02/18/2010		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER SASAN, ARADHANA				
ART UNIT 1615		PAPER NUMBER		
NOTIFICATION DATE 02/18/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/511,594

Applicant(s)

NGUYEN-KIM ET AL.

Examiner

ARADHANA SASAN

Art Unit

1615

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 December 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 04 January 2010. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 9, 13-15 and 28-34.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Aradhana Sasan/
Examiner, Art Unit 1615

/Robert A. Wax/
/Supervisory Patent Examiner, Art Unit 1615

Continuation of 11, does NOT place the application in condition for allowance because: Applicant's arguments (filed 12/01/09) have been fully considered but are not found persuasive. The added limitation of "0.2 to 25% by weight of vinylimidazole" was not present in previous claims 9, 28-32 and 34. This limitation raises new issues that would require further consideration and/or search.

Applicant's arguments with respect to the rejection of claims 13-15 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Wilhelm et al. (US 3,006,900) in view of Boeckh et al. (US 5,773,541) have been fully considered but are not persuasive. Applicant argues that "although acrylamide, methacrylamide, vinylpyrrolidone, or vinylimidazole as a unit (c) can be co-polymerized with the monomer (a), (b) and (d) of Boeckh et al., Boeckh et al. do not disclose selecting all three monomers, i.e., methacrylamide, vinylpyrrolidone, and vinylimidazole, as the unit (c) for the co-polymerization with each other and the monomers (a), (b) and (d) from a long list of possible monomers." This is not persuasive because the list of copolymerizable monomers disclosed by Boeckh is a limited or finite list that one of ordinary skill in the art would find obvious to combine.

Applicant argues that Boeckh et al. do not provide a single example comprising methacrylamide, vinylpyrrolidone, and vinylimidazole. This is not persuasive because a prior art reference is not limited to the exemplified embodiments. MPEP 2123 states: "A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments."

Applicant argues that in Boeckh et al, optional monomers (c) are necessarily co-polymerized with vinyl esters of aliphatic monocarboxylic acids and monoethylenically unsaturated carboxylic acids, which are not present in the claimed copolymers and the Wilhelm et al. copolymers. This is not persuasive because instant claim language does not specifically exclude the vinyl esters of aliphatic monocarboxylic acids and monoethylenically unsaturated carboxylic acids.

Applicant argues that one would not have been motivated to combine vinylimidazole of Boeckh et al. with co-polymer of Wilhelm et al. because Boeckh et al. suggest using 0-30% of the total of methacrylamide, vinylpyrrolidone, and vinylimidazole, while Wilhelm et al.'s co-polymers is based on 10-90 Wt.% of vinylpyrrolidone and 90-10 wt.% of methacrylamide. Applicant argues that the Examiner has also alleged the one would have predicted "success" in producing the claimed invention, however, the examiner has not explained why one would have expected "success" and what "success" is expected. This is not persuasive because Boeckh clearly teaches copolymerizable monomers from a limited, finite list, and discloses methacrylamide, N-vinylpyrrolidone and N-vinylimidazole (Col. 2, lines 45-65). One of ordinary skill in the art would find it obvious to substitute the water soluble compound of Wilhelm with the N-vinylimidazole that is copolymerizable with methacrylamide and N-vinylpyrrolidone of Boeckh with a reasonable expectation of producing a functional copolymer product. MPEP 2141 states that it is obvious to combine prior art elements (in this case the elements of Wilhelm and Boeckh) according to known methods (combining co-polymerizable monomers) to yield predictable results (i.e., producing a functional copolymer).